IN THE UNITES STATES PATENT AND TRADEMARK OFFICE

APPLICANT: BOYCE PENN	§	EXAMINER: JOHN R. PARADISO
SERIAL NO: 10/040,125	§	ART UNIT: 3725
FILED: 12/31/01	§	ATTY. DOCKET NO: BP5302

FOR: **APPARATUS AND METHOD FOR WORKING WITH SHEET MATERIAL**

CERTIFICATE OF FACSIMILE TRANSMISSION

I herby certify that this paper comprising 9 pages entitled RESPONSE TO OFFICE ACTION AND AMENDMENT is being sent via facsimile to the United States Patent and Trademark Office Central Fax (703) 872-9306

Mark Murphey Henry

7/30/04
Date of Transmission and Signature

RESPONSE TO OFFICE ACTION AND AMENDMENT

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In Response to the Office Action mailed 6/28/2004, please consider the following:

The Examiner contends that SCHULTZ (US 5,664,451), when coupled with McCLURE ET AL (US 1,272,068), constitutes an appropriate obviousness rejection predicated upon 35 U.S.C. § 103(a). The Examiner bases such obviousness rejection upon SCHULTZ disclosing "a method and apparatus for bending sheet metal in which slits are simultaneously formed in parallel with one another (See Fig. 1) and the material is then

bent along a line and a second row of slits are formed," which is thus combined with McCLURE ET AL disclosing "a method and apparatus in which metal is bent and cut by a pivoting/sliding blade (32) (See Fig. 3)." (Examiner's Rejection at 2). It is respectfully noted by Applicant that the element number (32) of McCLURE ET AL referenced by the Examiner (alleged to be in common with applicant's specification) is not defined as "a pivoting/sliding blade," rather, this element is defined as "a stationary blade or bar." col. 3, lines 12-13. It appears as well that the Examiner specifically rejects claims 1-20 on grounds of obviousness based upon SCHULTZ. Applicant directs primary attention to the dual references, McCLURE and SHULTZ.

The Examiner is of course aware that the Federal Circuit clearly dictates that an obviousness rejection made by combining prior art references (which is the situation here) requires the affirmative satisfaction of two questions: (1) whether the prior art would have ***suggested*** to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process, and (2) whether the prior art would also have ***revealed*** that in so making or carrying out, those of ordinary skill would have ***a reasonable expectation of success.***" *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (other citations omitted.)